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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VALERIE KUCHAREWSKI, MICHAEL TRAYLOR, MICHAEL
ANTHONY BUONOMO, JOHN PANZER, and JACK MAZZEO

Appeal 2009-012989
Application 10/715,215
Technology Center 2400

Before JOHN A. JEFFERY, HOWARD B. BLANKENSHIP, and THU A.
DANG, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

I. STATEMENT OF CASE

Appellants appeal the Examiner's second rejection of claims 1-20 under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

A. INVENTION

According to Appellants, the invention relates to the identification and creation of lists of contacts to which electronic messages may be sent from one or more communications applications (Spec. 1, ll. 12-13).

B. ILLUSTRATIVE CLAIM

Claim 1 is exemplary and reproduced below:

1. A method for enabling management of contacts, the method comprising:

passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member;

identifying, to the member, the set of contacts that has been passively recognized as a set of contacts that are, as a group, repeatedly sent communications by the member;

based on passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member, generating a contacts list that includes the set of contacts and that is useful in addressing future communications to the set of contacts as a group;

enabling the member to associate a name with the contacts list; and

enabling the member to address future communications to the set of contacts, as a group, through use of the name associated by the member with the contacts list.

C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Bates	US 6,247,043 B1	Jun. 12, 2001
Mathew	US 2004/0003071 A1	Jan. 01, 2004

Courant, “The Algebra of Sets,” *in* What is Mathematics?: An Elementary Approach to Ideas and Methods, 108-116 (Oxford University Press 1996)(herein “Courant”).

Claims 1-9, 12-16, and 19-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bates.

Claims 10-11 and 17-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bates in view of Mathew.

II. ISSUES

Has the Examiner erred in finding that Bates teaches “passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member” (claim 1), as Appellants contend?

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Bates

1. Bates discloses electronic messaging systems that automatically add an entry to a user's local address book (col. 2, ll. 53-56), and that permit users to be grouped together into "groups" that can be separately named and utilized to send electronic messages to multiple users at once (col. 2, l. 66 to col. 3, l. 2), wherein users that have corresponded with one another in the past may be considered to have a greater affinity than users who have not (col. 3, ll. 34-36).

Courant

2. Courant discloses that a set is defined by any property or attribute, wherein the set can contain an "empty set" which contains no elements (p. 108).

IV. ANALYSIS

35 U.S.C. § 102

Claims 1-9, 12-16, and 19-20

Appellants contend that "Bates does not describe or suggest passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member" but instead discloses "at most, determining whether a first individual user has exchanged more than a threshold number of communications with a second individual user" (App. Br. 6). In the Reply Brief, Appellants clarify that "[t]he Examiner's construction limiting the phrase 'a set of contacts' to an individual user, therefore, is incorrect"

(Reply Br. 2) and thus “Bates fails to describe or suggest passively recognizing that a set of multiple contacts are, as a group, repeatedly sent communications by a member” (*id.*).

However, the Examiner finds that “in light of the specification being silent to the terms ‘a set of contacts’ and ‘as a group,’” the Examiner “has interpreted these terms as broadly as possible in light of the specification and in terms of the art” (Ans. 13). In particular, the Examiner explains that “a set in the art is a ... mathematical term, which is understood to possibl[y] contain 0, 1, or a[n] infinite amount of objects” thereby “as [Appellants have] admitted[,] the prior [art] anticipates this feature by teaching an individual user who is passively recognized as a group of on[e] and a set of one” (*id.*). The Examiner cites to Courant (“The Algebra of Sets”) for the definition of a “set” and points out that “[Appellants have] not presented any additional arguments, and therefore [Appellants have] failed to distinguish over the prior art” (*id.*).

Appellants’ contention that “Bates fails to describe or suggest passively recognizing that a set of multiple contacts are, as a group, repeatedly sent communications by a member” (Reply Br. 2) is not commensurate in scope with the language of claim 1 since claim 1 does not recite any such “set of multiple contacts” limitation. Thus, an issue we address on appeal is whether Bates teaches “passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member” (claim 1), as specifically recited in claim 1.

We give the claims their broadest reasonable interpretation. *See In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004). Claim 1 does not place any limitation on what a “set” means, includes, or represents, other than reciting

that the “a set of contacts” is passively recognized “as a group, repeatedly sent communications by a member.” Further, we agree with the Examiner that the Specification is “silent [as] to the terms ‘a set of contacts’ and ‘as a group’” (Ans. 13).

Courant discloses that a set can contain any number of elements including no elements (FF 2). We agree with the Examiner that a set can possibly contain 0, 1, or an infinite amount of objects (Ans. 13). We therefore broadly but reasonably interpret a “set” as meaning any number of elements defining a particular property or attribute. Given this claim construction, we interpret “a set of contacts” (claim 1) as reading on any number of contacts defining a particular property or attribute.

Bates discloses automatically adding entries to a user’s local address book, wherein whether users that have corresponded with one another in the past are considered (FF 1). We find Bates to disclose passively recognizing whether users are repeatedly sent communications by other users. In fact, even Appellants admit that Bates discloses “determining whether a first individual user has exchanged more than a threshold number of communications with a second individual user” (App. Br. 6).

We agree with the Examiner that Bates teaches “passively recognizing that a set of contacts are, as a group” as required by claim 1 “by teaching an individual user who is passively recognized as a group of on[e] and a set of one” (Ans. 13). As the Examiner correctly points out, “[Appellants have] not presented any additional arguments, and therefore [Appellants have] failed to distinguish over the prior art” (Ans. 13).

Accordingly, we find that the Examiner did not err in rejecting claim 1 and independent claims 19 and 20 falling therewith, and claims 2-4, 6-9 and 12-16 depending therefrom under 35 U.S.C. § 102(b).

Appellants also argue that “[t]here is no teaching with this passage [of Bates] of enabling a member to delay the generation of a rejected contacts list, as recited in dependent claim 5” (Reply Br. 4). However, the Examiner finds that Bates discloses such teaching by requiring that the user accept by depressing a key (Ans. 5). We agree with the Examiner. That is, a skilled artisan would have understood that there is a delay when requiring the user to depress a key.

Appellants have not presented any additional argument to dispute that the Examiner has correctly shown where this claimed element appears in Bates. Accordingly, we find that the Examiner did not err in rejecting claim 5 under 35 U.S.C. § 102(b).

35 U.S.C. § 103(a)
Claims 10, 11, 17, and 18

Appellants do not provide arguments for claims 10, 11, 17, and 18 separate from those of claim 1. As we find no deficiencies with respect to the rejection of claim 1, we affirm the rejection of claims 10, 11, 17, and 18 depending from claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Bates and Mathew.

V. CONCLUSIONS

Appellants have not shown the Examiner erred in finding that claims 1-9, 12-16, and 19-20 are anticipated by the teachings of Bates.

Appellants have not shown the Examiner erred in concluding that claims 10-11 and 17-18 are unpatentable over the teachings of Bates and Mathew.

VI. DECISION

The Examiner's decision rejecting claims 1-9, 12-16, and 19-20 under 35 U.S.C. § 102(b) and rejecting claims 10-11 and 17-18 under 35 U.S.C. § 103(a) are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

peb

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